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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH D'AGOSTA

Appeal 2009-000973
Application 10/606,414
Technology Center 2800

Decided:¹ June 19, 2009

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1 and 3-17. *See* App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

STATEMENT OF THE CASE

Appellant invented a portable water heating system.²

Claim 1 which further illustrates the invention follows:

1. A portable water heating system, the system comprising:
 - a housing with an inside and an outside, the housing adapted to be portable to store and transport water received therein;
 - a water inlet disposed on the outside of the housing;
 - a first hose nipple attached to the water inlet, the first hose nipple adapted to connect a water source to the system;
 - a heating element adapted to heat water inside the housing;
 - an adjustable thermostatic control controlling the output of the heating element;
 - a lining disposed inside of the housing, the lining adapted to protect the inside of the housing from water corrosion;
 - a water outlet disposed on the outside of the housing; and
 - a second hose nipple attached to the water outlet, the second hose nipple adapted to connect a fluid conduit for heated water distribution.

The Rejections

The Examiner relies upon the following prior art references as evidence of unpatentability:

² *See generally* App. Br. 3-5 and Spec 2-6.

Rodriguez	U.S. 2,861,170	Nov. 18, 1958
Alston	U.S. 4,947,025	Aug. 7, 1990
Nelson	U.S. 4,974,551	Dec. 4, 1990
Twigg	U.S. 5,853,553	Dec. 29, 1998
Winter	U.S. 6,628,894 B2	Sep. 20, 2003

Claims 1 and 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodriguez and Alston (Ans. 3-4).

Claims 3, 7, 8 and 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodriguez, Alston and Winter (Ans. 5-6).

Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodriguez, Nelson and Twigg (Ans. 6-7).

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Claim 1³

Appellant argues that Rodriguez is directed to a water heating attachment for cold water pipes that is actually connected to a pipe for support and therefore is not adaptable to store and transport water to a desired location (App. Br. 6). The Examiner responds by arguing that the Appellant's use of "adapted to" in the claims does not impart a positive

³ Appellant argues claim 1 separately. *See* App. Br. 6-13.

limitation and therefore Rodriguez only has to disclose the ability to perform as set forth in the claim in order for the claim to read on Rodriguez (Ans. 8).

ISSUE

Has the Appellant shown that the Examiner erred in finding that the combination of Rodriguez and Alston discloses a portable water heating system adapted to be portable to store and transport water?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Rodriguez

1. Figure 1 of Rodriguez is reproduced below:

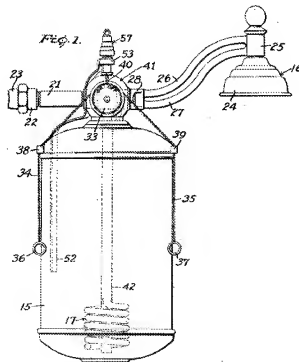


Figure 1 discloses a heating attachment for cold water pipes having a tank (15), a source of heat (17), shower unit (16), cold water supply pipe (23) coupled to the heater and thermostat.

2. Figure 6 of Rodriguez is reproduced below:

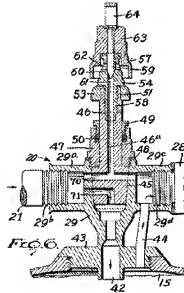


Figure 6 discloses a valve unit having a water inlet (29a), water outlet (29c), heated water tube (44), cold water port (70) and lift ring (64).

3. Rodriguez discloses on the outer surface of the tank a strip of metal (56) that can be marked or stamped with such legends as “closed,” “open,” “cold,” “hot,” “warm,” “tepid,” and / or “very hot” to guide the user of the device taking a shower (col. 3, ll. 30-35).

4. Rodriguez discloses a valve is used to adjust the temperature of the water by controlling the amount of cold water that is mixed with the heated water (col. 4, ll. 5-23).

5. Figure 9 of Rodriguez is reproduced below:



Figure 9 discloses a valve for controlling the amount of cold water that combines with the heated water from the heating element.

6. Rodriguez discloses using a thermostat (66) as a safety device that opens the circuit of the heating element whenever the temperature of the valve chamber rises to a predetermined point (col. 3, ll.62-67).

PRINCIPLES OF LAW

"[T]he PTO gives claims their "broadest reasonable interpretation." *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in

Graham v. John Deere Co., 383 U.S. 1, 17 (1966). If the Examiner's burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

The Appellant argues that Rodriguez's heating attachment includes a tank capable of holding water while attached to the cold water pipe (App. Br. 6-7). Appellant further argues that because the attachment is only intended to be used to heat and dispense water when it is connected to the cold water pipe it is not adaptable for transporting the water within its tank (App. Br. 6-7). As noted previously, the Examiner argues that the Appellant's use of "adapted to" in the claims does not impart a positive limitation and therefore Rodriguez only has to disclose the ability to perform as set forth in the claims in order for the claims to read on Rodriguez (Ans. 8). We agree with the Examiner's position.

The Appellant argues that the heat attachment cannot be adapted to be portable because it is connected to a cold water supply pipe (App. Br. 6). We disagree with the Appellant's position for several reasons. First, Rodriguez goes to great lengths to disclose that his invention has many applications such as providing heated water in camps, hunting and fishing lodges, in country homes and other places where hot water is needed but high installation costs are unwanted (col. 1, ll. 35-39). This disclosure by Rodriguez indicates that he recognizes that the heating unit has to be portable in order to service various locations. Further, the heating unit can

be coupled to a location via a cold water supply pipe alone (FF1 and col. 1, ll. 72-73). The claims only require that the heating system be adapted to be portable and we see no reason why Rodriguez's unit cannot be portable with a simple disconnection from the cold water supply pipe.

Appellant further argues that Rodriguez does not disclose the water heating attachment is portable, stores and transport water, and distributes heated water (Reply. Br. 3). This argument is not commensurate with the scope of the claims. Claim 1 indicates that the first hose is connected to a water source while the second hose is adapted to serve a conduit for heated water distribution. Claim 1 does not require the heating system to store and transport heated water for distribution. Therefore the Appellant's argument is not persuasive.

The Appellant also argues that Rodriguez's tank while capable of holding two-gallons of water while attached to a non-portable cold water supply pipe is not adaptable to transport the water held within its tank (App. Br. 6-7). Again, claim 1 only requires that the housing be "adapted to be portable to store and transport the water received therein" and we see no reason why with a simple disconnection from the non-portable cold water pipe that Rodriguez's unit cannot store and transport the water that it received.

Claim 1 requires "an adjustable thermostatic control controlling the output of the heating element." The Examiner indicated that although Rodriguez discloses the use of a thermostat (66), it is primarily used as a safety device to automatically open the circuit of the heating coil whenever the temperature of the valve chamber rises to a predetermined point (Ans. 4). *Also, see* FF 6. The Examiner relies upon Alston to disclose the adjustable

thermostatic control that controls the output of the heating element (Ans. 4). We agree with the Examiner that “[i]t would have been obvious to incorporate the teachings of Alston et al. as a means to offer the ability to adjust the temperature of the water in accordance with the desires of the consumer.” (Ans. 4). However, Rodriguez also discloses that the consumer can adjust the temperature of the water by an adjustable thermostatic controller. *See* FF 2-5. Most importantly, Rodriguez discloses that the output of the heating element can be adjusted by a thermostatic control that controls the amount of cold water that interacts with the heated water thus controlling the output of the heating element (FF4-5).

We also agree with the Examiner’s assertion that Rodriguez’s thermostat could be interpreted as adjustable and therefore the “adjustable thermostatic control” claim limitation would read on the Rodriguez reference (Ans. 4). Rodriguez discloses a thermostat (66) that is used for safe operation of the heating attachment that automatically opens the circuit of the heating coil whenever the temperature of the valve chamber rises to a predetermined point (FF 6). The thermostat had to be adjusted to that predetermined value; therefore, it is considered to be adjustable. Therefore, for these reasons, we find that Rodriguez actually anticipates claim 1. Nevertheless, we agree with the Examiner’s obviousness rejection based on Rodriguez and Alston as obviousness rejections can be based on references that happen to anticipate the claimed subject matter. *See In re Meyer*, 599 F.2d 1026, 1031 (CCPA 1979).

We therefore sustain the Examiner’s rejection of claim 1 for the reasons stated previously.

Claims 3-17

Regarding the obviousness rejections of (1) claims 4-6 over Rodriguez and Alston (Ans. 3-4); (2) claims 3, 7, 8 and 12-17 over Rodriguez, Alston and Winter (Ans. 5-6); and (3) claims 9-11 over Rodriguez, Nelson and Twigg (Ans. 6-7), we find that Appellant has not persuasively rebutted the Examiner's prima facie case of obviousness for these claims, but merely contended that the additional references fail to cure the previously-noted deficiencies of Rodriguez and Alston (App. Br. 6-13).

Once the Examiner has satisfied the initial burden of presenting a prima facie case of obviousness, the burden then shifts to Appellant to present evidence and/or arguments that persuasively rebut the Examiner's prima facie case. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Since Appellant did not particularly point out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness, the rejections are therefore sustained.

CONCLUSION

Appellant has not shown that the Examiner erred in finding that the combination of Rodriguez and Alston disclosed a portable water heating system adapted to be portable to store and transport water.

ORDER

We have sustained the Examiner's decision rejecting claims 1 and 3-17.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

Appeal 2009-000973
Application 10/606,414

AFFIRMED

gvw

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